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**SEP 29 2005**

**OFFICE OF PETITIONS**

In re Application of:	:
Simon Prisant	:
Application No. 10/694,389	:
Filed: October 28, 2003	:
Title of Invention: METHOD AND	:
SYSTEM FOR REMOTE PURCHASE PAYMENTS:	

This is in response to a petition under 37 CFR 1.47(b), filed January 18, 2005, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors. The delay in treating this petition is regretted.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on October 28, 2003, and included a declaration executed by Eli Dahan, and a Declaration of Jean Levy (hereinafter the "Levy Declaration"). The Levy Declaration provides that the nonsigning inventor expressly refused to join in the application. The Levy Declaration also provides that, under Israeli Law, the nonsigning inventor is obligated to assign all rights in the above-identified application to the Rule 47(b) Applicant. Mr. Levy "ha[s] been employed by Sanford T. Colb & Co., an

Intellectual Property Law Firm in Isreal, since April 24, 1995, and [is] currently in the position of Head of the Foreign Filing Department." *Levy Declaration* at p.1.

With the filing of the executed Declaration, this Office entered the declaration and made the declaration of record, and while a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed to Applicant, there was no mention of the need to file an oath or declaration in compliance with 37 CFR 1.63.

With the instant petition, Applicant provides that the declaration executed by Mr. Dahan and filed with the application on October 28, 2003, was improper<sup>1</sup>. Applicant files a declaration with the petition executed by Mr. Yair Tamir. A Declaration by Mr. Tamir is also filed with the instant petition which identifies Mr. Tamir as the Managing Director of Teltry Systems Limited ("Teltry"), successor in interest to the above-identified application.

#### Applicable Law

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable harm. Applicant lacks items (2) and (5).

As to item (2), the Office notes that pursuant to Section 409.03(b)(A) of the Manual for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary,

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<sup>1</sup> Applicants filed a petition under 37 CFR 1.47(b) in application 10/009,740 (which is the national stage entry of PCT/IL00/00331), and of which the above-identified application is a continuation. The petition included the declaration executed by Mr. Dahan. That petition was dismissed in a Decision mailed March 31, 2003. The Decision dismissing the petition noted that Mr. Dahan lacked the capacity to execute the declaration on behalf of the nonsigning inventor.

Treasurer or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). (Emphasis supplied). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

Applicant has not presented an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 37 CFR 1.64. The MPEP provides that "[a] person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee." See, MPEP 324. Also, the title or position of the person signing must be stated on the declaration. A properly executed oath or declaration is required.

As to item (5), applicant failed to show or provide proof that Teltry has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b)

applicant (company), a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant.

Here, Applicant has provided the Levy Declaration, which states that under Isreali Law, the nonsigning inventor is obligated to assign all rights in the above-identified application to the Rule 47(b) Applicant. This statement falls short of a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant. Moreover, the Levy Declaration provides that Mr. Levy is employed by the firm as Head of the Foreign Filing Department. The Declaration fails to state whether Mr. Levy is an attorney familiar with the law of the jurisdiction. Further to this, a review of the documents filed with the instant petition fail to reveal an employment agreement between the non-signing inventor and the Rule 47(b) applicant (company), or a copy of an assignment agreement showing that the invention disclosed in the application was assigned to the Rule 47(b) applicant by the nonsigning inventor.

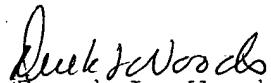
Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Commissioner for Patents  
                             PO Box 1450  
                             Alexandria, VA 22313-1450

By FAX:                   (703) 872-9306  
                             Attn: Office of Petitions

By hand:                   2201 South Clark Place  
                             Customer Window  
                             Crystal Plaza Two, Lobby Room 1B03  
                             Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.



Derek L. Woods

Petitions Attorney  
Office of Petitions